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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,897	07/25/2001	Kosei Terada	393032003810	7946
25224	7590	02/27/2006	EXAMINER	
MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024			CALLAHAN, PAUL E	
		ART UNIT		PAPER NUMBER
				2137

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/912,897	TERADA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Paul Callahan	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 September 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 24-34,37-41,52 and 54-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 24-32,37-41,52 and 54-59 is/are rejected.
- 7) Claim(s) 33 and 34 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 June 1999 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. 09/111,605.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 218 D 6
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-53 were originally pending in this application. Claims 1-23, 35, 36, 42-51 and 53 have been cancelled via the first preliminary amendment filed 7-25-2001. New claims 54-59 have been added via the second preliminary amendment filed 9/23/2005. Therefore claims 24-34, 37-41, 52 and 54-59 are pending and have been examined.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 38, 40, and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims each contain the passage: "wherein said main information incorporates with additional information" and "wherein said further comprises". The phrases appear to be colloquialisms. As such it is unclear what the applicant intends the phrases "incorporates" and "said further" to mean, or whether some text was inadvertently left out of the passages.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 28 and 59 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed towards data that has undergone the embedding and encryption process via the method of claim 24, and which is recited as being embodied in a memory medium. The claim does not contain a limitation directed towards data, embodied in the memory medium, that when read out causes a change in an apparatus. Hence the claim is directed towards non-functional descriptive material, i.e., non-statutory subject matter. (See MPEP Sec. 2106).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 24-32, 37, 39, 54, 55, 57, and 58 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Barton, US 5,646,997.

As for claims 24 and 32, Barton teaches a method of encrypting main information (col. 7 lines 14-20: "Step 4"), data of said main information including a group of data units (col. 6 lines 19-21 and 40-40: the data stream segmented into blocks, reading on claim 32 as well since each block is separated based on a predetermined characteristic

length), said method comprising: a first step of incorporating data of encrypting information representative of an encrypting procedure, dispersedly into particular ones of the data units belonging to a predetermined first data group of said main information (col. 4 lines 16-21, col. 6 lines 19-21, 40-48: the embedding process is carried out for each block, col. 7 lines 1-5 and 20-25: data indicative of the encryption process is appended to the embedded bit string for each block), and a second step of executing the encrypting procedure, represented by said encrypting information, on the data belonging to a predetermined second data group of said main information (col. 11 lines 34-36).

As for claim 25 Barton teaches a method as recited in claim 24 wherein said first step further incorporates predetermined additional information, other than said encrypting information, into said first data group of said main information (col. 2 lines 56-59, col. 4 lines 16-21).

As for claim 26, the claim is directed towards the apparatus carrying out the method steps of claim 24 and is rejected on the same basis as that claim.

As for claim 27, the claim is directed towards the computer program product embodied in a memory medium, that when read out causes an apparatus to carry out the method steps of claim 24. Claim 27 is therefore rejected on the same basis as claim 24.

As for claim 28, the claim is directed towards data embodied in a machine-readable memory medium that is configured in a manner according to the method steps of claim 24. Therefore claim 28 is rejected on the same basis as is claim 24.

As for claim 29, Barton teaches the claim limitations that are held in common with claim 24 as discussed supra, and the additional claim limitations of claim 29 not held in common with claim 24 of: a method of decoding and reproducing encrypted main information (fig. 2); a first step of reproducing said encrypting information from said first data group of said main information having said encrypting information incorporated therein (col. 11 lines 34-39, col. 7 lines 55-67, col. 8 lines 1-28); and a second step of, on the basis of said encrypting information reproduced by said first step, decoding the data belonging to said second data group to thereby reproduce said main information (col. 8 lines 1-28).

As for claim 30, the claim is directed towards the apparatus that carries out the method steps of claim 29 and is therefore rejected on the same basis as is that claim.

As for claim 31, the claim is directed towards the computer program product embodied in a memory medium that, when read out, causes an apparatus to carry out the method steps of claim 29 and is therefore rejected on the same basis as is that claim.

As for claim 37, Barton teaches a method as recited in claim 24 wherein said main information to be encrypted is provided in a form of a real-time data stream (abstract); wherein said first step incorporates the data of encrypting information, in real time, into said main information of the real-time data stream (col. 4 lines 16-21, col. 6 lines 19-21, 40-48), and said second step executes the encrypting procedure, in real time, on said main information of the real-time data stream (col. 11 lines 34-36); and wherein said method further comprises a step of transmitting to a communication network said main information having said encrypting information incorporated therein and having been encrypted by said second step, in a form of the real-time data stream (col. 4 lines 58-67, col. 5 lines 1-9:transmission of the data is discussed).

As for claim 39, Barton teaches the method as recited in claim 29 wherein said main information to be decoded is transmitted via a communication network, in a form of a real-time data stream (col. 4 lines 16-21 and 58-67, col. 6-lines 19-21, 40-48); wherein said method further comprises a step of receiving said main information of the real-time data stream transmitted via the communication network (col. 4 lines 58-67, col. 5 lines 1-9:transmission of the data is discussed); wherein said first step reproduces said encrypting information from said first data group of said main information of the real-time data stream received via the communication network (col. 11 lines 34-39, col. 7 lines 55-67, col. 8 lines 1-28); wherein said second step decodes, on the basis of said encrypting information reproduced by said first step, the data belonging to said second

data group of said main information of the real-time data stream received via the communication network to thereby decode said main information (col. 8 lines 1-28).

Claim 54 is directed to the transmission apparatus that carries out the method of claim 37 and is therefore rejected on the same basis as that claim.

Claim 55 is directed to the receiving apparatus that carries out the method of claim 39 and is therefore rejected on the same basis as is that claim.

As for claim 57, the claim is directed towards the computer program product embodied in a memory medium that when read out causes an apparatus to carry out the method of claim 37 and is therefore rejected on the same basis as is that claim.

As for claim 58, the claim is directed towards the computer program product embodied in a memory medium that when read out causes an apparatus to carry out the method of claim 39 and is therefore rejected on the same basis as is that claim.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 52, 56, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton, and Rosenberg et al. US 6,363,357.

As for claims 52, and 59, Barton teaches the method as recited in claim 24, wherein said main information is music performance information (col. 5 line 60: audio signal); and wherein said method further comprises a step of transmitting the music performance information after the execution of said encrypting procedure by said second step (col. 4 lines 58-67, col. 5 lines 1-9:transmission of the data is discussed). Barton does not teach a step whereby at a receiving end, only portions, other than a particular portion corresponding to said data belonging to the predetermined second data group, of the music performance information can be reproduced by every person while the particular portion of the music performance information having undergone the encrypting can be reproduced only by an authorized person. Rosenberg however does teach allowing a subset of an audience access to encrypted data, with every member of the audience can access non-encrypted portions of the data (abstract, col. 2 lines 44-67). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Barton. Motive to make the combination is discussed in col. 2 lines 44-67 of Rosenberg where the desirability of allowing the potential buyer to select data for access purchase based on a small unencrypted sample of the data and associated in-band meta data is discussed.

As for claim 56, Barton teaches system as recited in claim 55, but not one which further comprises a section that displays said additional information reproduced by said decoder section. Rosenberg does teach display of such meta data however (abstract, col. 2 lines 44-67). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Barton. Motive to make the combination is discussed in col. 2 lines 44-67 of Rosenberg where the desirability of allowing the potential buyer to select data for access purchase based on a small unencrypted sample of the data and associated in band meta data is discussed.

***Allowable Subject Matter***

10. Claims 33 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter: the closest prior art in the field, Barton and Rosenberg, do not teach the features of claim 24 where additionally, each characteristic group (data block) is encrypted via a separate, unique algorithm. Claim 34 is dependent on claim 33 and is therefore indicated as allowable also.

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***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

2-18-06

*Paul Callahan*

*Matthew P. Smither*  
MATTHEW SMITHERS  
PRIMARY EXAMINER  
*Art Unit 2137*